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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,072	02/06/2004	John Ginder	81094501	2071

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EXAMINER

PADGETT, MARIANNE L

ART UNIT PAPER NUMBER

1762

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,072

Applicant(s)

GINDER ET AL.

Examiner

Marianne L. Padgett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-19 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 11, 20, 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicants' amendments have removed the 112, first & second paragraph rejections, as well as the prior art rejections under 103, but have not removed the obviousness double patenting rejections, hence they are repeated below.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5, 7-8, 12-16, 19, 21-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-6, 8-9 & 11-15 of U.S. Patent No. 6,773,763. Although the conflicting claims are not identical, they are not patentably distinct from each other because as discussed in section 7 of the action mailed 5/23/2006, the claims of the patent (763) encompass overlapping sets of limitations that are claimed in different orders and varying semantics, noting that the independent claims detail the requirements of the kinetic spraying process & claim 14 explicitly uses the term; claims 12-15 are directed to specifically electric machines that may be motors or generators or require the formation of a coil; and claims 2-3 & 8-9 are directed to claimed deposition materials, thus one of ordinary skill in the art would find that the claims in the present application represent obvious variations of the claims of the (763) patent. It is further noted that the metals (Cu, Al, Ag & Au) claimed in application claims 7 & 26 for the coils, are those conventionally used for electrically conductive wiring, and as such would have been expected or typical metals to be employed

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for the coils, which would have been required to be electrically conductive for the functions claimed, thus obvious to one of ordinary skill in the art to employ for the claimed purpose.

4. Claims 1-10, 12-19 & 21-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-6, 8, 10 & 12-13 of U.S. Patent No. 6,592,935 in view of Wehde (3,739,248), or Porrazzo et al (6,137,891), and/or admitted prior art, as discussed above in section 3 and section 8 of the action mailed 5/23/2006.

As previously noted, although the conflicting claims are not identical, they are not patentably distinct from each other because the kinetically spraying technique for producing the permanent magnets are of overlapping scope with limitations therefore claimed in different orders representing obvious variations of the process. The (935) patent further differs by not requiring the permanent magnet to be used in forming an electric machine, such as motor, but as delineated above this would have been an obvious use in view of admitted prior art to Wehde or Porrazzo et al, where it was especially noted that given the admissions in the specification of known construction of motors and given the suggestion in Wehde or Porrazzo et al of spray deposition of such structures, to employ the (935) patent's deposition process in making these known structures by a spray process as taught.

5. Claims 1-10, 12-19 & 21-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 47, 51-56, 58 & 61-67 of U.S. Patent No. 7097885 (previously SN 10/463,747), in view of Wehde (3,739,248), or Porrazzo et al (6,137,891), and/or admitted prior art, as discussed above in sections 3-4, and previously in section 9 of the action mailed 5/23/2006.

6. Claims 1-10, 12-19 & 21-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/064,583, in view of Wehde (3,739,248), or Porrazzo et al (6,137,891), and/or admitted prior art, as discussed above in sections 3-4.

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Analogous to the above rejections the (583) application's claims are of overlapping scope, including dependent claims directed to a motor or a generator or a second component having a kinetically sprayed coil, but lacks specific details of the assembly of the second substrate with the coils with the substrate with the magnetic material, which would have been obvious in view of the secondary references as discussed above.

This is a provisional obviousness-type double patenting rejection, however it is further noted that the 10/064583 application has received a notice of allowance, hence may be expected to shortly become non-provisional.

7. Applicant's arguments filed 8/23/2006 have been fully considered but they are not persuasive, as the obviousness double patenting rejections remain in the case, however it is noted that on page 13 of the 8/23/2006 response, in the remarks, applicants have stated their willingness to submit Terminal Disclaimers upon indication that the subject matter is otherwise allowable. As all other rejections have presently been removed, this appears to be the case, pending update of the search upon receipt of the aforementioned Terminal Disclaimers.

Claims 11, 20 & 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (or if the terminal disclaimers are supplied).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action

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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne L. Padgett whose telephone number is (571) 272-1425. The examiner can normally be reached on M-F from about 8:30 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks, can be reached at (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLP/dictation software

10/29/2006



**MARIANNE PADGETT
PRIMARY EXAMINER**